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| 10/522,299 | 07/11/2008 | Wolfgang Otto Budde | DE 020188 | 1502 |
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| EXAMINER | | | | |
| WRIGHT, BRYAN F | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/522,299

Applicant(s)

BUDDE ET AL.

Examiner

BRYAN WRIGHT

Art Unit

2431

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 7-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/13/2009 has been entered. Claims 1 and 17 are amended. Claims 5 and 6 are cancelled. Claims 1-4, and 7-17 are pending.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1 and 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim(s) 1 of copending Application No. 10521719. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are characterized as a security system for transmitting a key record utilizing short range communication. Each instant of the claims contains the subject matter of a security system and a worldwide unambiguous key. Claim(s) of the instant application therefore is/are not patently distinct from the earlier patent claim(s) and as such is/are unpatentable over obvious-type double patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

"Claim 1 and 17 of this application is generic to the species of invention covered by claim 1 in copending Application No. 10521719. Thus, the generic invention is "anticipated" by the species of the patented invention. Cf., Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim) . This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the

generic application. In re Van Ornum, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982). Accordingly, absent a terminal disclaimer, claim 1 and 17 were properly rejected under the doctrine of obviousness-type double patenting." (In re Goodman (CA FC) 29 USPQ2d 2010 (12/3/1993)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-4 and 7-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hermann et al. (European Patent Application No. 1024626 and Hermann hereinafter) in view of Dellmo et al. (Patent Publication No. 2002/0094087 and Dellmo).

3. As to claim 1, Hermann teaches a security system for wireless networks, comprising:

a first portable unit(i.e., ... teaches a device such at but not limited to PDA, smart cards, badges [par. 39];

with a memory for storing a key record provided for short-range information transmission of the key record (i.e.,... teaches a first and second device architecture [par. 45]),

at least part (e.g., password) of said key record (e.g., sequence) is provided by a user to create a key record that is worldwide unambiguous (i.e., ...teaches part of the sequence (i.e., key record) sent to second device containing a password used to authenticate a user [par. 44]),

a triggering unit for triggering a short-range transmission of the worldwide unique key record (i.e., ... teaches sending a initialization token to thru short-range transmission the short-range [par.. 45]).

means for erasing said key record (e.g., initialization token) after an occurrence of one of (i.e., ...teaches a due date attached to the initialization token [par. 52]);

said transmission and a predetermined time interval (i.e., ...teaches a due date attached to the initialization token [par. 52]);

and at least one receiving unit in at least one wireless apparatus of the network (i.e., ... teaches a second receiving unit in a wireless communication network [abstract]),

comprising a receiver for receiving the worldwide unambiguous key record and an evaluation component of the apparatus for storing (i.e., ... teaches a second receiver device [par. 45] ... teaches second device receives information teaches information receives is evaluated for communication authentication purposes [par.44]),

processing and/or passing on the worldwide unambiguous key record (4) or a part of the worldwide unambiguous key record to a second component (i.e., ... teaches a sending key data to second party [par. 46]).

Hermann does not expressly teach:

wherein said triggering unit is activated when said portable unit and said receiving unit are within a distance to each other such that signal energy from said receiving unit received by said portable unit exceeds a predetermined voltage level.

However, at the time of applicant's original filing the use of an automatic level control (e.g., voltage signal) for the purpose of communication was well known in the art and would have been an obvious modification of the system disclosed by Hermann as introduced by Dellmo. Dellmo discloses:

wherein said triggering unit is activated when said portable unit and said receiving unit are within a distance to each other such that signal energy from said receiving unit received by said portable unit exceeds a predetermined voltage level (to provide a voltage control interface (e.g., RF) such that a voltage signal of a predetermined amplitude is used to carry to the signal between receiver and transmitter [par. 42]).

Therefore, given Hermann ability to provide security in a wireless environment, a person having ordinary skill in the art at the time of the invention would have recognized the desirability and advantage of modifying Hermann to control a transmission data signal by employing the well known feature of automatic voltage control as disclosed by Dellmo in a wireless environment.

4. As to claim 2, Hermann teaches a security system characterized in that the key record in the memory of the portable unit is predetermined by the manufacturer (i.e., ... teaches a wireless communication between devices [fig. 2] ... those skilled in the art would recognize the inherent to wireless device communication is the communication pertinent manufacturing device information transmission between communicating device for initialization and setup purposes).

5. As to claim 3, Hermann teaches a security system characterized in that the portable unit comprises an input device for providing the key record to the memory (i.e., ... teaches a description of network devices in [par. 39] ... the teaching of network devices in par. 39 describes a PDA those skill in the art would recognize inherent to a PDA is a means to input information and store information).

6. As to claim 4, Hermann teaches a security system characterized in that the input device is adapted to detect biometric characteristics of a user and derive the key record

from and/or authenticate the user by means of said biometric characteristics (i.e., ... teaches Human Interface Device (HID) for which can recognize voice [par. 39]).

7. Claim 5. (Cancelled).

8. Claim 6. (Cancelled).

9. As to claim 7, Hermann teaches a security system characterized in that, upon a user's approach to the receiving unit, a detector unit in the unit triggers the short-range information transmission of the worldwide unambiguous key record (i.e., ... teaches access points and point to point communication [par. 36] ... teaches a RF and IR networks [par. 42] ... those skilled in the art would recognize inherent to RF and IR technology are detectors to receive and process signal).

10. As to claim 8, Hermann teaches a security system characterized in that a key generator is provided in the first unit or in a second unit for generating a sequence of guest key records (i.e., ... teaches a generating a key [par. 48]).

11. As to claim 9, Hermann teaches a security system characterized in that the first unit is provided for transmitting a guest key record upon activation of a second triggering unit (i.e., ... teaches transmitting a key to a second party [par. 48]).

12. As to claim 10, Hermann teaches a security system characterized in that the key record and the guest key record each consist of a bit sequence (i.e., ... teaches a use of digital devices [par. 39] ... teaches a generating key data [par. 46] ... those skill in the art would recognize bit processing (e.g., constructing a bit sequence) as inherent behavior digital devices).

13. As to claim 11, Hermann teaches a security system characterized in that the first unit is a part of an apparatus, particularly a remote control unit [abstract].

14. As to claim 12, Hermann teaches a security system characterized in that the worldwide unambiguous key record is supplied during or before a network configuration, particularly an automatic network configuration, of an apparatus [par. 46].

15. As to claim 13, Hermann teaches a security system characterized in that the key record and the guest key record comprise characterizing bits which are provided for distinguishing between key records and other bit sequences and characterize bit sequences as key record or as guest key record (i.e., ... teaches a use of digital devices [par. 39] ... teaches a generating key data [par. 46] ... those skill in the art would recognize bit processing (e.g., constructing a bit sequence) as inherent behavior digital devices).

16. As to claim 14, Hermann teaches a security system characterized in that the apparatus is provided for erasing the guest key record (i.e., ... teaches a use of a nonce [par. 47] ... those skilled in the art would recognize a nonce is temporal and values are unique).

17. As to claim 15, Hermann teaches a security system characterized in that the apparatus is provided for authentication and encryption of useful data to be transmitted between the apparatuses of the network by means of a key comprised in the key record [par. 46].

18. As to claim 16, Hermann teaches a security system characterized in that the apparatus identifies its association in with a wireless network by means of a key comprised in the key record [par. 47].

19. As to claim 17, Hermann teaches a portable unit for installing a shared key with a key record in at least one apparatus of a wireless network comprising a memory for storing the key record (i.e., public key) which is provided for short- range information transmission of the key record [pa. 47].

wherein a characteristic is provided by a user to create a key record that is worldwide unambiguous (i.e., ...teaches part of the sequence (i.e., key record) sent to second device containing a password used to authenticate a user [par. 44]),

a triggering unit for initiating a short range transmission of said key record (i.e., ... teaches sending a initialization token to thru short-range transmission the short-range [par. 45 & 52]). and means for erasing (e.g., due date) said characteristic after one of (i.e., ...teaches a due date attached to the initialization token [par. 52]);

a transmission of said key record and a predetermined time interval (i.e., ...teaches a due date attached to the initialization token [par. 52]);

Hermann does not expressly teach:

a signal detecting unit;

wherein said triggering unit is activated to initiate said short range transmission after a signal energy/detected by said detecting unit exceeds a predetermined voltage level.

However, at the time of applicant's original filing the use of an automatic level control (e.g., voltage signal) for the purpose of communication was well known in the art and would have been an obvious modification of the system disclosed by Hermann as introduced by Dellmo. Dellmo discloses:

a signal detecting unit (to provide signal detection capability [par. 42, fig. 7]);

wherein said triggering unit is activated to initiate said short range transmission after a signal energy/detected by said detecting unit exceeds a predetermined voltage level (to provide a voltage control interface (e.g., RF) such that a voltage signal of a

predetermined amplitude is detected based on the automatic control interface between receiver and transmitter [par. 42]).

Therefore, given Hermann ability to provide security in a wireless environment, a person having ordinary skill in the art at the time of the invention would have recognized the desirability and advantage of modifying Hermann to control a transmission data signal by employing the well known feature of automatic voltage control as disclosed by Dellmo in a wireless environment.

20. Claim 18. (Cancelled).

Response to Arguments

Applicant's Remarks – 112th 1st Paragraph

Examiner withdraws the 112th 1st paragraph rejection for claim 17 in view of applicant's amendment.

Examiner finds applicant's arguments to be persuasive with regard to the 112th 1st paragraph rejection of claims 1, 7 and 12 and therefore the Examiner withdraws rejection.

Applicant's Remarks – 103 Rejection - Hermann in view of Lewis

Applicant's arguments with respect to claims 1-4, and 7-17 have been considered but are moot in view of the new ground(s) of rejection.

Examiner Remarks to Applicant's alleged deficiencies on the part of Hermann -

With regards to applicant's remarks of, "... specifically fails to disclose that a part of the key record is provided by the user to create a key record that is worldwide unambiguous", the Examiner contends Hermann discloses sending a sequence to a receiver device; the sequence comprising key data, and a password [par. 44]. Applicant states as part of applicant's original disclosure that authentication data is used to comprise part of "the key record" transmitted to the receiver. The Examiner respectfully submits those skilled in the art would recognize a password as authentication data.

With regards to applicant's remarks of, "However, this system of Hermann and Lewis would fail to disclose the claim element of "passing on the worldwide unambiguous key record or a part of the worldwide unambiguous key record to a second component", the Examiner contends with regards to the alleged deficiency on the part of Hermann, that Hermann discloses passing a sequence comprising a password and key data to a receiver [par. 44]. In this instance the sequence is equivalent to applicant's key record. The Examiner further adds any alleged deficiency on the part of Lewis is now mute in view of the new rejection made under Hermann in view of Dellmo.

With regards to applicant's remarks of, "Hermann does not provide any teaching regarding short range transmission or the transmission when a receiving signal energy is above a predetermined voltage level or any means for erasing the key record after

one of a transmission or a predetermined time, as is now recited in the claims", the Examiner contends Hermann discloses the use of a "due date" (e.g., erase means) associated with the sequence information (e.g., key record) sent to the receiver [par. 52]. With regards to the "predetermine energy" claim element the Examiner respectfully submits the teachings of Dellmo provides voltage signal detection circuitry [par. 42].

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRYAN WRIGHT whose telephone number is (571)270-3826. The examiner can normally be reached on 8:30 am - 5:30 pm Monday -Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BRYAN WRIGHT/
Examiner, Art Unit 2431

/William R. Korzuch/
Supervisory Patent Examiner, Art Unit 2431